

E7 e-mail reminders web page that allows designation of how often the e-mail reminder message is to be sent.

REMARKS

I. Introduction

Applicants have filed concurrently herewith a Petition for a one-month extension of time for replying to the Office Action and have paid the fee required under 37 C.F.R. §§ 1.136(a) and 1.17(a)(1). With the extension, the time for response is extended up to and including March 6, 2003.

Claims 1-76 are pending.

Applicants have amended claims 9-13, 20, 28-32, 65, 67, 68, 73, 75, and 76. No new matter is being added and the amended claims are fully supported by applicants' originally filed specification.

Claims 9-17, 28-36, 65-68, and 73-76 were rejected under 35 U.S.C. § 112. Claims 1-76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fries, U.S. Patent No. 6,317,885 ("Fries") in view of Goodhand et al., U.S. Patent No. 5,923,848 ("Goodhand"), the "Fries-Goodhand Combination."

These rejections are respectfully traversed.

II. Applicants' Reply To The Rejections
Under 35 U.S.C. § 112

Claims 9-17, 28-36, 65-68, and 73-76 were rejected under 35 U.S.C. § 112, stating that "it is not clear as to whether [the new and current] reminders are e-mail reminders." Applicants have amended claims 9-13, 28-

32, 65, 67, 68, 73, 75, and 76 to include the term "e-mail." No new matter is being added.

IV. Applicants' Reply To The Rejections
Under 35 U.S.C. § 103(a)

Claims 1-76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Fries-Goodhand Combination. However, applicants respectfully submit that, for the reasons set forth in detail below, the Office Action has failed to establish a *prima facie* case of obviousness and the § 103 rejections should therefore be withdrawn. See MPEP §§ 2142 and 2143.

A. The Fries-Goodhand Combination Fails to Show Or Suggest All Elements Of Applicants' Claimed Invention

Applicants' system and method of independent claims 1 and 20, generally relate to providing e-mail reminders for an "Internet television program guide." As set forth in independent claims 1 and 20, "television program listings" are provided "over the Internet" to a user's "multimedia system." The user selects "a television program from the television program listings" and may "order at least one e-mail reminder message" for the selected television program. E-mail reminder messages are sent "over the Internet via e-mail" to "remind the user when [the selected] television program is to be broadcast." Dependent claims 2-19 and 21-76 include additional patentable features.

The Office Action correctly acknowledges that Fries* "remains silent on the specific teachings of e-mail for transport of reminder messages." ** See page 4 of the Office Action. Fries also fails, however, to show or suggest an *Internet television program guide* for "providing web pages of television program listings over the Internet." Instead, Fries merely discloses that *pre-rendered images* of information may be transmitted by a head-end over a designated television channel. See column 6, lines 43-55. The pre-rendered *images* in Fries are derived from an external data source 48 (e.g., the Internet) and transmitted as video signals from a cable head-end 22 to a television set-top box 28 over a local cable television system. See FIG. 1 and the accompanying text at column 3, lines 21-41; see also FIG. 2 and the accompanying text at column 3, line 41 - column 4, line 16.

When compared to the system and method of applicants' claims 1 and 20, Fries' technique of transmitting pre-rendered images of information over a local cable television system would obviously require additional processes and equipment. Specifically, Fries discloses that information derived from interactive information server 46 must first be converted into the pre-rendered image before being transmitted to users. See column 6, lines 48-52. Applicants' claims 1 and 20, on the

* Although the Office Action states "Goodhand remains silent...", applicants believe that the Office Action should have stated "Fries remains silent..." as this statement follows a discussion of Fries.

** Applicants respectfully submit that, because Fries fails to show or suggest "send[ing] the e-mail reminder message...over the Internet via e-mail," Fries must also fail to show or suggest allowing users "to order at least one e-mail reminder message" as set forth in applicants' claims 1 and 20.

other hand, require no such conversion and provide for transmitting "**web pages** of television program listings" directly to users. The Office Action attempts to modify Fries with the disclosure of Goodhand to show applicants' claimed approach, but nothing in Goodhand compensates for these deficiencies in Fries. The Office Action states, rather, that "Goodhand discloses sending e-mail reminders." Goodhand relates to an e-mail system that generates notifications and reminders for flagged e-mail messages and due dates (see column 4, lines 53-57), but nothing in Goodhand shows or suggests sending an "e-mail reminder message...over the Internet via e-mail to remind the user when [a] **television program is to be broadcast**" as set forth in applicants' claims 1 and 20.

Accordingly, the Fries-Goodhand Combination does not show or suggest all features of applicants' independent claims 1 and 20, and the rejections under § 103 should be withdrawn. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art"); see also MPEP § 2143.03. Dependent claims 2-19 and 21-76 are likewise patentable over the Fries-Goodhand Combination.* See In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988) ("Dependent claims are non-obvious under 35 U.S.C. § 103 if the independent claims from which they depend are non-obvious").

* Dependent claims 2-19 and 21-76 include additional patentable features. Applicants reserve the right to demonstrate the patentability of these claims should prosecution of this case continue.

B. The Office Action Does not Provide a Sufficient Motivation for Making the Fries-Goodhand Combination

Even if the Fries-Goodhand Combination shows or suggests every element of applicants' claims 1 and 20, as the Office Action contends, the § 103 rejections must be withdrawn because the Office Action fails to provide a sufficient motivation for combining the references. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01.

Fries discloses an approach for sending reminders (and other information) to users as pre-rendered images transmitted over a dedicated television channel. See column 6, lines 43-55. The Office Action fails to explain why one skilled in the art would have been motivated to deviate from the approach already provided in Fries and incorporate applicants' claimed approach of providing e-mail reminder messages over the Internet.

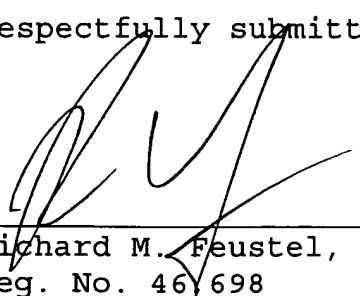
Instead, the Office Action merely concludes that it would have been obvious to modify Fries with Goodhand "to provide a system for generating e-mail reminders for specific events at specific times." See page 4 of the Office Action. This is tantamount to saying that it would have been obvious to combine Fries and Goodhand because it would have lead to applicants' claimed approach. But such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also MPEP § 2143.

Indeed, because they are based on "subjective belief and unknown authority," the conclusory statements provided by the Office Action are improper and "do not adequately address the issue" of providing an objective motivation to combine the references. In re Lee, 61 USPQ2d 1430, 1434. Without an objective motivation to combine the references, the Office Action "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. In re Dembiczak at 999. For at least these reasons, the § 103 rejections should be withdrawn.

V. Conclusion

The foregoing demonstrates that claims 1-76 are patentable over the Fries-Goodhand Combination. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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AMENDED CLAIMS IN MARKED-UP FORM PURSUANT TO
RULE 121(C) (1) (ii)

9. (Twice Amended) The system defined in claim 1 wherein the web pages provide a view current e-mail reminders option which the user selects to receive a list of current e-mail reminder orders.

10. (Twice Amended) The system defined in claim 9 wherein the web server presents a view current e-mail reminders web page when the user selects the view current e-mail reminders option.

11. (Twice Amended) The system defined in claim 1 wherein the web pages provide a new e-mail reminders option which the user selects to order an e-mail reminder message by entering a program title.

12. (Twice Amended) The system defined in claim 11 wherein the web server presents a new e-mail reminders web page when the user selects the new e-mail reminders option.

13. (Twice Amended) The system defined in claim 12 wherein the new e-mail reminders web page provides at least one selectable option.

20. (Four Times Amended) A method for providing e-mail reminder messages of scheduled television events to a user at a multimedia system over the Internet using an Internet television program guide system, the method comprising:

providing web pages of television program listings over the Internet;

~~selecting~~ providing the user with an opportunity to select a television program from the television program listings provided over the Internet; and providing the user with an opportunity to order at least one e-mail reminder message for the selected television program; and

providing e-mail reminder messages to the multimedia system over the Internet via e-mail that remind the user when the television program is to be broadcast.

28. (Twice Amended) The method defined in claim 20 further comprising providing a view current e-mail reminders option which the user selects to receive a list of current e-mail reminder orders.

29. (Twice Amended) The method defined in claim 28 wherein the providing of the view current e-mail reminders option further comprises presenting a view current e-mail reminders web page when the user selects the view current e-mail reminders option.

30. (Twice Amended) The method defined in claim 20 further comprising providing a new e-mail reminders option which the user selects to order an e-mail reminder message by entering a program title.

31. (Twice Amended) The method defined in claim 30 wherein the providing of the new e-mail reminders option further comprises presenting a new e-mail reminders web page when the user selects the new e-mail reminders option.

32. (Twice Amended) The method defined in claim 31 wherein the presenting of the new e-mail reminders web page further comprises providing selectable options displayed on the new e-mail reminders web page when the user is presented with the new e-mail reminders web page.

65. (Amended) The system defined in claim 12 wherein the new e-mail reminders web page receives designations for a plurality of destinations to which the e-mail reminder message is to be sent.

67. (Amended) The system defined in claim 65 wherein the new e-mail reminders web page provides a selectable option that allows designation of a time at which the e-mail reminder message is to be sent.

68. (Amended) The system defined in claim 65 wherein the new e-mail reminders web page provides a selectable option that allows designation of how often the e-mail reminder message is to be sent.

73. (Amended) The method defined in claim 31 further comprising accepting through the new e-mail reminders web page designations of a plurality of destinations to which the e-mail reminder message is to be sent.

75. (Amended) The method defined in claim 73 further comprising providing a selectable option on the new e-mail reminders web page that allows designation of a time at which the e-mail reminder message is to be sent.

76. (Amended) The method defined in claim 73 further comprising providing a selectable option on the new e-mail reminders web page that allows designation of how often the e-mail reminder message is to be sent.